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| 09/867,746 | 05/31/2001 | Bijan Tadayon | 111325-63 | 5716 |

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EXAMINER

SHERR, CRISTINA O

| | |
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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,746

Applicant(s)

TADAYON ET AL.

Examiner

Cristina O Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to the Application filed 31 May 2001. Claims 1-14 have been examined in this application.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on 9 August 2002 and 30 July 2002 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Hurtado et al (US 6,611,812B2).
6. Regarding claim 1 -

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Hurtado discloses a method of transferring digital works from one user to another user comprising: associating usage rights, transfer permission information, and a current user identification flag, with digital content; distributing a digital work including the content to a first user in accordance with the usage rights and setting the current user identification flag to correspond to the first user; and transferring the digital work to a second user and setting the current user identification flag to correspond to the second user (col 5 ln 59 – col 6 ln 13).

7. Regarding claim 2 –

Hurtado discloses a method as recited in claim 1, wherein said transferring step comprises changing the usage rights in accordance with the transfer to the second user (col 19 ln 24-28).

8. Regarding claim 3 –

Hurtado discloses a method as recited in claim 2, wherein said changing step comprises changing the usage rights to permit use of the content by the second user and to prohibit use of the content by the first user (col 23 ln 39-58).

9. Regarding claim 4 –

Hurtado discloses a method as recited in claim 1, further comprising receiving notification that the user desires to distribute the digital work to a second user (col 24 ln 39-58).

10. Regarding claim 5 –

Hurtado discloses a method as recited in claim 1, wherein said transferring step comprises transferring usage rights without change for remaining usage period of time to the second user (col 25 ln 23-41).

11. Regarding claim 6 –

Hurtado discloses a method as recited in claim 2, wherein said transferring step further comprises downloading the content from the first user to the second user (col 19 ln 24-28).

12. Regarding claim 7 –

Hurtado discloses a method as recited in claim 2, wherein said transferring step further comprises downloading the content from a distributor to the second user (col 23 ln 39-58).

13. Regarding claim 8 -

Hurtado discloses a method as recited in claim 1, further comprising checking for transfer permission prior to said transferring step (col 24 ln 39-58).

14. Claims 9-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hurtado et al (US 6,611,812B2).

15. Regarding claim 9 -

Hurtado discloses a system for transferring digital works from one user to another user comprising: digital content; a usage rights module containing usage rights information associated with the content for a user; a transfer permission module containing transfer permission information for the content; a current user identification module containing identity information indicating the identity of the user; and means for manipulating said

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current user identification module to change the identity information (col 5 ln 59 – col 6 ln 13).

16. Regarding claim 10 –

Hurtado discloses a system as recited in claim 9, further comprising means for changing the usage rights in accordance with a change in identity information (col 19 ln 24-28).

17. Regarding claim 11 –

Hurtado discloses a system as recited in claim 9, wherein said usage rights module and said digital content are encrypted (col 6 ln 2-9).

18. Regarding claim 12 –

Hurtado discloses a system as recited in claim 11, wherein said usage rights module and said digital content are attached to one another as an encapsulated element (col 5 ln 60-65).

19. Regarding claim 13 –

Hurtado discloses a system as recited in claim 12, wherein said transfer permission module and said current user identification module are located remotely from said encapsulated element (col 5 ln 60-65).

20. Regarding claim 14 –

Hurtado discloses a method as recited in claim 9, wherein said means for manipulating said current user identification module is responsive to a notification that the user desires to distribute the digital work to a second user (col 24 ln 39-58).

21. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

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Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

23. Ginter et al (US 6,427,140B1) discloses systems and methods for secure transaction management and electronic rights protection.

24. Kupka et al (US 6,434,535B1) discloses a system for prepayment of electronic content using removable media and for prevention of unauthorized copying of same.


25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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JAMES P. TOMCZAK
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER